



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
600 GALLERIA PARKWAY, S.E.
STE 1500
ATLANTA GA 30339-5994

MAILED

NOV 22 2010

OFFICE OF PETITIONS

In re Application of :
Moore :
Application No. 10/642,309 : DECISION ON SECOND RENEWED
Filed: August 18, 2003 : PETITION PURSUANT TO
Attorney Docket No. 60707-1330 : 37 C.F.R. § 1.47(B)
Title: OPERATING SYSTEM FOR :
EXECUTING COMPUTER SOFTWARE :
APPLICATIONS :
:

This is in response to the second renewed petition pursuant to 37 C.F.R. § 1.47(b), filed October 14, 2010.

This second renewed petition pursuant to 37 C.F.R. § 1.47(b) is **DISMISSED**.

The concurrently submitted petition pursuant to 37 C.F.R. § 1.183 is being **held in abeyance** so as to provide Petitioner an opportunity to respond to this decision.

On August 18, 2003 this application was filed with an unexecuted declaration, identifying Mark Justin Moore as the sole inventor. On August 18, 2004, an executed declaration was submitted, along with the surcharge associated with the late submission of the same. In a final Office action mailed on December 12, 2007, a non-final Office action mailed on July 2, 2008, and a final Office action mailed on January 21, 2009, the Examiner objected to the declaration.

A grantable petition under 37 C.F.R. § 1.47(b) requires:

- (1) the petition fee of as set forth in 37 C.F.R. § 1.17(g);

- (2) the surcharge as set forth in 37 C.F.R. § 1.16(e), if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventor;
- (4) proof that either:
 - (a) a copy of the application was sent or given to the non-signing inventor for review and proof that the non-signing inventor refused to sign, or;
 - (b) proof that diligent efforts have been made to locate the non-signing inventor
- (5) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (6) proof of irreparable damage, and;
- (7) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 C.F.R. § 1.63.

An original petition pursuant to 37 C.F.R. § 1.47(b) was filed on November 23, 2009, along with, *inter alia*, the petition fee, a statement of facts, an assertion that the non-signing inventor cannot be found,¹ and the last known address of the non-signing inventor.² The original petition was dismissed via the mailing of a decision on January 29, 2010, which indicated that requirements (1) - (3) of Rule 1.47(b) had been satisfied, and requirements (4) - (7) had not been satisfied.

A renewed petition pursuant to 37 C.F.R. § 1.47(b) was filed on April 29, 2009 along with, *inter alia*, a statement pursuant to 37 C.F.R. § 3.73(b),³ proof of irreparable damage, and an acceptable declaration. The renewed petition was dismissed via the mailing of a decision on January 29, 2010, which indicated that to date, requirements (1) - (3) and (5) - (7) have been satisfied.

Regarding the fourth requirement of Rule 1.47(b), the decision on the original petition set forth, *in pertinent part*:

Petitioner has indicted that he has inquired with the non-signing inventor's former co-workers,⁴ performed "multiple Internet

¹ Original petition, pages 1 and 4.

² Id. at 3.

³ It is noted that the corresponding assignment was recorded in the Office on February 16, 2010. Additional assignments were recorded on March 1, 2010 and March 11, 2010.

⁴ Original Petition, page 2. See also Exhibits C4 and C5.

"searches" for this individual,⁵ and neither these communications nor these searches were successful in locating this individual.⁶ As Petitioner has set forth that the non-signing inventor cannot be found or reached, Petitioner is required to establish that a diligent effort was made to locate this individual. However the cursory searches that were performed for the non-signing inventor using three online search engines and inquiries with former co-workers do not constitute a diligent effort at locating this individual. The record does not support a finding that diligent attempts were made to obtain a forwarding address or to locate the non-signing inventor by means such as through telephone, databases, or a private locator service. If such searches are performed, and are sufficiently broad so as to provide a reasonable opportunity to locate this individual, and it is then averred that such attempts failed, then Petitioner will have provided the necessary proof required under 37 C.F.R. § 1.47 that the non-signing inventor cannot be reached. Details of the efforts to locate the non-signing inventor are to be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Emphases included.

The decision on the renewed petition set forth, in pertinent part:

With this renewed petition, Petitioner has indicated that he contacted a Spanish law firm and made the additional step of mailing a letter to the non-signing inventor on February 12, 2010.⁷ The sending of a letter, coupled with the prior efforts which have been undertaken, do not constitute a diligent effort at locating the non-signing inventor.

With this second renewed petition, Petitioner has indicated that a private investigation service was retained, and has described a conversation between an agent of the private investigation service and the non-singing inventor. However, no statement from the agent of the private investigation service has been provided, and as set forth on page 3 of both the decision on the original petition and the decision on the renewed petition:

Details of the efforts to locate the non-signing inventor are to be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Emphases included.

It follows that the description of the conversation which allegedly took place between an agent of the private investigation service and the non-singing inventor cannot be

5 Original Petition, page 2. See also Exhibit C6 and C7.

6 Exhibits C5 and C7, submitted with the original petition.

7 Exhibit C8, submitted with the renewed petition. See also Exhibits C10 and C11, submitted contemporaneously therewith.

accepted, due to the fact that it appears to be based on hearsay: the record strongly suggests that Petitioner does not have firsthand knowledge of the contents of this conversation.

On third renewed petition, Petitioner should include a statement of facts from the agent of the private investigation service.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Third Renewed Petition pursuant to 37 C.F.R. § 1.47(b)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Any such third renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,⁸ hand-delivery,⁹ or facsimile.¹⁰ Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.¹¹

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.¹² All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

⁸ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁹ Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

¹⁰ (571) 273-8300: please note this is a central facsimile number.

¹¹ <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

¹² Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).